



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,671	05/03/2006	Julian Bonnerjea	2006-0763	4399
513	7590	05/27/2010		
WENDEROTH, LIND & PONACK, L.L.P.			EXAMINER	
1030 15th Street, N.W.,			SAUNDERS, DAVID A	
Suite 400 East				
Washington, DC 20005-1503			ART UNIT	PAPER NUMBER
			1644	
			NOTIFICATION DATE	DELIVERY MODE
			05/27/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/595,671	BONNERJEA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David A. Saunders	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10/9/09 & 3/17/10.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,6-11,13,16-21 and 23-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1-4,6-11,13 and 21 is/are allowed.

6) Claim(s) 16-20,23,25 and 26 is/are rejected.

7) Claim(s) 24 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **AMENDMENT ENTRY**

Amendment of 3/17/10 has been entered. Claims 1-4, 6-11, 13, 16-21 and 23-26 are pending and are under consideration.

## **CORRECTIONS REGARDING PREVIOUS OFFICE ACTION**

The following corrections pertain to the previous Office action:

At page(s) 8, last full para., line 1, "xx" should have read as –JP 7-55194 A in view of Racher et al and EP 0,284,268--.

## **OBJECTION(S)/REJECTION(S) OF RECORD WITHDRAWN**

The amendment has overcome previously stated issues as follows:

The objection to claim(s) 13 and 17-20.

The rejection of claim(s) 1 and 13 under 35 USC 112, 2<sup>nd</sup> paragraph, for inconsistent terminology.

The rejection of claim(s) 5 and 12 under 35 USC 112, 2<sup>nd</sup> paragraph, since these claims have been cancelled.

The rejection of claim(s) 1, 8, 11, 13, 14 and 19-21 under 35 USC 112, 2<sup>nd</sup> paragraph for recitations of "preferably".

The 102 prior art rejection of claim(s) 1-6, 8-13, 15-16 and 21-22 based upon Bonnerjea et al (WO 2004/076485), since the limits of claims 7 and 14 have been incorporated, respectively, into claims 1 and 13.

The 103 prior art rejection of claim(s) 1-6, 8-13 and 21 based upon JP 7-155194 A in view of Racher et al and, as necessary, EP 0,284,268, since the limits of claims 7 and 14 have been incorporated, respectively, into claims 1 and 13.

The prior art rejection of claim(s) 17 based upon JP 7-155194 A in view of Racher et al and, as necessary EP 0,284,268, and further in view of Wan et al (6,177,548). This rejection falls for the same reasons that the rejection of claim(s) 1-6, 8-13 and 21 based upon JP 7-155194 A in view of Racher et al and, as necessary, EP 0,284,268 has been withdrawn.

### **MAINTAINED OBJECTION(S) TO DISCLOSURE**

The amendment filed 5/3/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The incorporation by reference of Prov. Applic. Ser. No. 60/608,104 is improper, since it was not stated in the specification at the International Stage.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicant's arguments filed 10/9/09 have been fully considered but they are not persuasive. The arguments have urged, firstly, that the International Bureau recognized the claim for priority to the US Prov. Applic. The examiner notes that a mere recognition of a claim for priority is not a recognition that applicant can later incorporate a part of or all of the priority document by reference. If applicant wanted to incorporate Prov. Applic. Ser. No. 60/608,104 by reference, the time to do so was when the International Application was filed.

The arguments have urged, secondly, that the US Oath/Declaration claims benefit of 2 provisional applications, including 60/608,104. Again, the examiner notes that a mere claim for priority does not provide a basis for incorporating the priority

document by reference. Mere reference to another application, such as an application to which applicant claims priority, is not an automatic incorporation by reference of that application. See *In re De Seversky* 177 USPQ 144. Furthermore, whether a claim to priority may or may not have been present at the time of filing the US, National Stage application is not relevant, since applicant's filing date was the International Filing date; if applicant wanted to incorporate Prov. Applic. Ser. No. 60/608,104 by reference, the time to do so was at the time of the International Filing date.

### **NEW REJECTION(S) UNDER 35 USC 112, SECOND PARAGRAPH**

Claims 16-20, 23 and 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 16-20, all recitations of "the product protein" or "product protein" lack antecedent basis in claim 1. Since claims 19-20 are thus rejected, further dependent claims 25-26 are included in the statement of the rejection.

In claim 23, "may be" is indefinite. Why is the "wherein" clause in which "may be" is recited even necessary? Whatever embodiments are encompassed by "may be" are sufficiently recited in further dependent claim 24.

### **OBJECTED TO CLAIMS**

Claim 24 would be allowable if claim 23, from which claim 24 depends, is rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph set forth supra.

### **FINALITY**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

## CONTACTS

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, whose telephone number is 571-272-0849. The examiner can normally be reached on Mon.-Thu. from 8:00 am to 5:30 pm and on alternate Fridays. The examiner's supervisor, Ram Shukla, can be reached on 571-272-0735. The fax number where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Typed 5/18/10 DAS

/David A Saunders/

Primary Examiner, Art Unit 1644

Application/Control Number: 10/595,671  
Art Unit: 1644

Page 6